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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,925	06/02/2000	LIONEL JEAN	GEM-400	5660

21839 7590 06/17/2005

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EXAMINER

ZIA, SYED

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/462,925

Applicant(s)

JEAN ET AL.

Examiner

Syed Zia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,12,14-16 and 22 is/are rejected.
- 7) ☒ Claim(s) 2,3,7-11,13,17-21,23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on March 31, 2005. Original application contained Claims 1-24. Applicant previously amended Claims 1, 2, 7, 10-12, 21-22, and 24. Applicant currently amended Claims 5, and 15. The amendment filed have been entered and made of record. Presently pending claims are 1-24.

Allowable Subject Matter

Claims 2-3, 7-11, 13, 17-21, 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

1. Applicant argument regarding Claim 1 rejection under 35 U.S.C. 112, second paragraph is persuasive. Therefore, previous rejection under 35 U.S.C. 112, second paragraph is withdrawn.

2. Regarding Claim 1 rejection under 35 U.S.C. 112, first paragraph, examiner still assert that all removable and portable objects, as explained by applicant, are not external to a system, for example some computer system use external hard disk or CD ROM to perform certain additional functions, such as extra storage etc., but in order to be operational in first place that computer system need a required storage (hard disk, CD ROM etc) and that required storage is not external to the system, because the system need that storage as part of system assembly to be fully functional and operational.

In this case of applicant invention the security circuit need to be resided (i.e. plugged in) on the terminal when smart card is inserted to terminal in order to perform the counting function. This portable smart object (with security circuit), as explained by applicant, is a component of secure terminal assembly along with smart card (5). Therefore counting operation is not done externally to smart card (5) because portable smart object (with security circuit) is plugged in to terminal using the same interface as smart card (5) is plugged in to terminal in order make the system work as a secure terminal, and to perform the required counting function by the terminal. Therefore, previous rejection under 35 U.S.C. 112, first paragraph is still maintained

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claimed subject matter *externally* of the smart card, which does not provide necessary description what does externally constitute? Whether counting, is done on a separately mounted device connected by a wire (or wirelessly i.e. remotely) to the terminal or counting is done on a removable device connected by a wire (or wirelessly i.e. remotely)

Claim Objections

Applicant amended the claims 5 and 15 to overcome the objection. Therefore previous objection has been withdrawn.

Response to Arguments

Applicant's arguments filed on March 31, 2005 have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 1 applicants argued that the system of cited prior arts (CPA) [Tamada et al. U.S. Patent No. 4,879,645, and Branham (WO 93/25024)] at least do not teach, "counting operation that are performed externally of the smart card because RAM is an internal component of smart card", and also does not teach "concept of counting the number of time a request is made". Applicant also argued that there is no motivation to combine the teachings of two references".

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This is not found persuasive. The system of cited prior arts clearly teaches method of data processing system with integrated circuit smart card to stops running of specific program when count value of execution counter is above predetermined limit which also includes external security device which stores copies of host boot sector file allocation table and electronic fingerprints of executable files on host system. Thus, managing a secure terminal in data processing system using a system of smart card. Prior to the running of each program by the secure terminal, it is judged whether or not the program is a specific one. If it is the specific program, the execution counter counts up and when the count value reached a predetermined limit, the running of that program is prevented, thus making the secure terminal unavailable (abstract).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, please refer col.1 line 10 to line 32.

As a result, CPA does implement and teaches a system and method of managing a secure terminal.

Applicants still have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts.

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The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. The examiner will not interpret to read narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the examiner asserts that CPA does teach or suggest the subject matter broadly recited in independent Claim 1, and in subsequent dependent Claims 2-24. Accordingly, rejections for claims 1-24 are respectfully maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 4-5, 12, 14-15, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamada et al. U.S. Patent No. 4,879,645 ("Tamada" hereinafter) and further in view of Branham (WO 93/25024) ("Branham" hereinafter).
2. Regarding claim 1, Tamada disclose a method of managing a secure terminal used for transactions with smart cards (see abstract; Fig. 1), comprising:

detecting placement of a smart card in contact with the terminal (see Fig. 1; col. 2, lines 20-23, and 48-50);

executing a program by the terminal, said program including sensitive operations related to making the transactions secure (see col. 2, lines 32-40);

counting, externally of the smart card, the number of times a request is made to the terminal to execute sensitive operations (see col. 1, lines 36-43; col. 2, lines 54-62);

restricting the action of said terminal when the counted number reaches a predetermined value (see col. 1, lines 36-43; col. 4, lines 3-9).

Although the system disclosed by Tamada show all the features of the claimed limitation, but it does not specifically disclose the a removable security circuit device *external to the smart card and terminal* when terminal operates to restrict the operation when certain conditions are present.

In an analogous art, Branham, on the other hand, discloses computing security environment for monitoring with an external security device (Fig.1 Item 15). This monitoring external security device has an interface to write to host system (i.e. terminal) (Fig.1, Item 12). The communications between host system (i.e. terminal) and this external security device (i.e. external to smart card and terminal) are protected by requiring device-specific information to initiate the communication (Fig.1, Page 3 line 16 to line 33, and Page 4 line 17 to line 30).

It would have been obvious to one skilled in the art at the time of invention was made to combine the teachings of Tamada and Branham, because Branham's *external and removable* security device will make the system of Tamada further secure for counting management program operation, and to ensure that smart-card reading terminals are not employed for uses

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outside of the application to which they are dedicated by restricting the operation of the terminal when certain required conditions, such as security concerns, are present. Thus, this intelligent external and removable characteristic of Branham security device (i.e. circuit) will also let the terminal to perform non-sensitive operation when the counted number of sensitive operations requested of the terminal reaches a maximum value.

3. Claims 4-5, and 12 are rejected applied as above rejecting Claim 1. Furthermore, the system of Tamada and Branham teaches and describe a method of managing a secure.

As per claim 4, further comprising: as sensitive operation, performing a mutual identification procedure between the terminal and the card (see Tamada: col. 2, lines 13-31).

As per claim 5, further comprising: as a sensitive operation, performing an authentication (PIN) of a carrier of the smart card (see Tamada: col. 2, lines 14-31).

As per claim 12, comprising the management means that is capable of identifying and counting requests coming from outside the security circuit and restricting functions of said security circuit as soon as the counted number reaches a predetermined number (see Tamada: col. 2, lines 54-62).

4. Claims 14, and 22 are rejected applied as above rejecting Claim 13. Furthermore, the system of Tamada and Branham teaches and describe a method of managing a secure.

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As per claim 14, further comprising: as sensitive operation, performing a mutual identification procedure between the terminal and the card (see Tamada: Fig. 1; col. 1, lines 46-49; col. 2, lines 13-22).

As per claim 22, comprising the management means that is capable of: identifying and counting requests coming from outside the security circuit and restricting functions of the security circuit as soon as the counted number reaches a predetermined number (see Tamada: col. 4, lines 10-25).

5. Claim 15 is rejected applied as above rejecting Claim 14. Furthermore, the system of Tamada and Branham teaches and describe a method of managing a secure.

As per claim 15, further comprising: as a sensitive operation, performing an authentication (PIN) of a carrier of the smart card (see Tamada: col. 2, lines 14-31).

6. Claims 6, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamada et al. U.S. Patent No. 4,879,645, in view of Branham (WO 93/25024) and further in view of Asad et al. U.S. Patent No. 6,539,093 ('Asad' hereinafter).

Claims 6, and 16 are rejected applied as above rejecting claim 1, and 13. Furthermore, the system Tamada and Branham teaches all the limitations as above as indicated in claim 1, and 13.

Tamada does not disclose a sensitive operation, performing a verification of a certificate coming from a smart card.

However, Asad discloses a sensitive operation, performing a verification of a certificate coming from a smart card (see col. 3, lines 43-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Asad within the system of Tamada and Branham to arrive at the invention as claimed because both references are directed to placing a smart card in contact with a terminal, and because the implementation of performing a verification of a certificate of Asad in Tamada and Branham would further certify that the information coming from the smart card is authentic and that the card is authorized to access the terminal, further increasing the level of security and extending the capabilities of the combined system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 571-272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SZ
June 12, 2005


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